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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,993	02/25/2004	Henry Gembala	GEMHPA304	4481

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EXAMINER

MERCIER, MELISSA S

ART UNIT	PAPER NUMBER
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1615

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/27/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/786,993	Applicant(s) GEMBALA, HENRY	
	Examiner Melissa S. Mercier	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Summary

Claims 1-14 are pending in this application. Claims 1-14 are rejected.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5 and 8-12 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims are drawn to a composition for use in asphalt and coal tar mixtures comprising an odor masking agent and a holding agent. A holding agent, as described in the specification, can include diethyl phthalate, diethylene glycol methyl ethers, and many other common esters, glycols, and alcohols. Thus, the claims are drawn to a genus of organic compounds that is defined only by biological activity.

To provide adequate written description and evidence of possession of a claimed genus, the specification must provide sufficient distinguishing identifying characteristics

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of the genus. The factors to be considered include disclosure of the complete or partial structure, physical and/or chemical properties, functional characteristics, structure/function correlation, methods of making the claimed product, or any combination thereof. In this case, the only factor present is that the compound is organic. There is no description of structural characteristics are required to retain biological activity. Accordingly, in the absence of sufficient recitation of distinguishing characteristics, the specification does not provide adequate written description of the claimed genus.

Vas-Cath, Inc. v. Mahurkar, 19USPQ2d 111, clearly states, "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the 'written description' inquiry, whatever is now claimed." (See page 1117) The specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." (See *Vas-Cath* at page 1116). As discussed *supra*, the skilled artisan cannot envision the detailed chemical structure of the encompassed genus of organic compounds, and therefore conception is not achieved until reduction to practice has occurred, regardless of the complexity or simplicity of the method of isolation or synthesis. Adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method of isolating or synthesizing it. The compound itself is required. See *Fiers v. Revel*, 25 USPQ2d 1601 at 1606 (CAFC 1993) and *Amgen Inc. v. Chugai Pharmaceutical Co. Ltd.*, 18 USPQ2d 1016.

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Therefore, only diethyl phthalate and diethylene glycol methyl ether, but not the full breadth of the claims, meets the written description provision of 35 U.S.C. § 112, first paragraph. Applicant is reminded that *Vas-Cath* makes it clear that the written description provision of 35 U.S.C. § 112 is severable from its enablement provision (see *Vas-Cath* at page 1115). See also *In re Barker*, 559 F.2d 588, 591, 194 USPQ 470, 472 (CCPA 1977) (a specification may be sufficient to enable one skilled in the art to make and use the invention, but still fail to comply with the written description requirement).

Claims 1, 3-8, 10-14 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

M.P.E.P. § 2163 states, "An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention...one must define a compound by 'whatever characteristics sufficiently distinguish it'. A lack of adequate written description issue also arises if the knowledge and level of skill in the art would not permit one skilled in the art to immediately envisage the product claimed from the disclosed process."

While the specification describes a species of the instantly claimed odor masking agents at p.4, it does not describe a sufficient number of species as to convey

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possession of the entire genus encompassed by odor masking agents. Applicants have provided adequate written description for concentrated extracts of vanilla, peppermint, cinnamon, and synthetic bubble gum fragrance. Applicants have not provided written description of natural and synthetic oils, including lemon and orange oils, or glycols, glycol ethers, alcohols, esters, aldehydes, and ketones for use as odor masking agents.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4-5, 7, and 11-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding Claims 4, 7, and 11, the phrase "including" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). It is suggested that the claims be amended to recite the limitations as "selected from the group consisting of".

Regarding Claims 5 and 12, it is unclear to the examiner why glycols, glycol ethers, alcohols, esters, aldehydes, and ketones are listed as groups of odor masking agents. The specification on page 4, describes them as holding agents. The Examiner is therefore interpreting them to be both odors masking agents and holding agents.

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, 7-12 and 14 rejected under 35 U.S.C. 102(b) as being anticipated by Berkeley (US Patent 3,832,459).

Berkeley discloses, "commercial application of the products of the disclosed relate to its use as an air deodorizer. A deodorant can be one which functions by desensitizing the nasal passages to odors by masking the odorous material, by reacting with odor-causing material to form non-odorous compounds or by destroying microorganisms that generate malodors. Typical of such selective types of deodorants are the organic hydroperoxides, the acrylic esters and the quaternary morpholinium alkyl sulfates in combination with masking agents such as perfumes and essential oils" (column 4, lines 51-63) It is the examiners position that these are pure organic compounds. Masking agents disclosed include orange oil, lemon oil, peppermint oil, and synthetic musks" (column 7, lines 11-17). It is the Examiners position that synthetic musks would comprise ketones.

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Claims 1, 3, 5-8, 10, and 12-14 rejected under 35 U.S.C. 102(b) as being anticipated by Pera (US Patent 4,906,488).

Pera discloses, "a method of modifying a permeant comprising forming a liquid system including a solution of a mer with a permeant, reacting the mer in the presence of the permeant in a portion of the liquid system which contains substantial amounts of both mer and permeant for significantly increasing the molecular weight of the mer under conditions which substantially preserve at least one useful permeant function of the permeant (column 2, lines 14-23).

Pera discloses permeants include esters, such as diethyl phthalate, ethers, alcohols, aldehydes, ketones, synthetic and natural essential oils (column 3, line 50 through column 4, line 68 and Examples 3 and 6).

Claims 1-14 rejected under 35 U.S.C. 102(e) as being anticipated by Wohrle et al. (US Patent 6,566,562).

Wohrle discloses, "the perfume oils comprising the isolongifolenol can be diluted with a solvent for perfumings. Suitable solvents for this purpose are, for example, diethylene glycol monoethyl ether, and diethyl phthalate" (column 9, lines 3-9).

Wohrle further discloses, "examples of perfume oils include: extracts from natural raw materials such as essential oils, concretes, absolutes, resins, resinoids, balsams, tinctures, such as, for example, orange oil; peppermint oil; vanilla extract; cinnamon leaf oil; cinnamon bark oil; and fractions thereof, or ingredients isolated therefrom" (column 4, line 48 through column 5, line 23).

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Additional fragrances can include ketones, alcohols, aldehydes, ethers, esters, for example (columns 5-8).

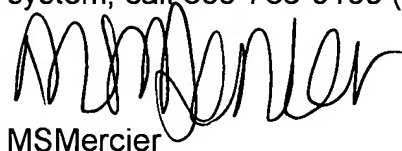
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent 6,667,059 and PG Pub 20030068295.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa S. Mercier whose telephone number is (571) 272-9039. The examiner can normally be reached on 7:30am-4pm Mon through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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